

## **REMARKS**

Upon entry of the foregoing amendment, Claims 1-11 and 13-20 will remain pending in the application. Claim 12 has been canceled, and Claims 1-4, 10-11, 13-14 and 18 have been amended. These changes do not introduce new matter, and their entry is respectfully requested.

In the Office Action of March 25, 2008, the Examiner set forth a number of grounds for rejection. These grounds are addressed individually and in detail below.

### **Claim Rejections under 35 U.S.C. §112, second paragraph**

Claims 2-4, 10 and 18 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for the reasons set forth on pages 2-3. Claims 2-4, 10 and 18 have been amended to better describe the claim invention. Applicants respectfully submit that the amendments obviate the grounds of the rejection. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

### **Claim Rejections under 35 U.S.C. §102**

Claims 1-7, 11-15 and 18-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 20050083741 to Chang (hereinafter “Chang”) for the reasons set forth on pages 3-14. Applicants respectfully traverse the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a

person of ordinary skill in the field of the invention. Scripps Clinic Research & Foundation v. Genentech Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Independent Claim 1, as amended, is directed to a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled to a host computer having an operation system with an AutoRun mechanism, comprising: (1) the operation system of the host computer sending out an inquiry command to the semiconductor storage device for detecting a type of the device; (2) the semiconductor storage device replying to the inquiry command from the operation system based on one or more predetermined device types; (3) the operation system of the host computer deeming the semiconductor storage device as one type of the predetermined device types according to the reply from the semiconductor storage device, and performing an operation accordingly; and (4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates said deemed device type so that a specific file directed by the searched AutoRun configuration file can be executed by the operation system, said searching step comprising: (4-1) the operation system sending out a second inquiry command to detect whether an optical disk is inserted into the optical disk drive when the semiconductor storage device is deemed to be an optical disk drive; (4-2) **in response to the second inquiry command, the semiconductor storage device, which simulates an optical disk drive, replying to the operation system after a predetermined delay, that an optical disk is already inserted into the optical disk drive so that the operation system can deem the semiconductor storage device as an optical disk with an optical disk;** and (4-3) the AutoRun mechanism of the operation system searching for the AutoRun configuration file stored in the

semiconductor storage device which simulates the optical disk drive with an optical disk so that the operation system can execute the specific file directed by the AutoRun configuration file.

Independent Claim 11, as amended, is directed to a method of AutoRun using a semiconductor storage device, the semiconductor storage device being coupled with a host computer having an operation system with an AutoRun mechanism, comprising: (1) the operation system of the host computer sending out a first inquiry command to the semiconductor storage device for detecting the type of the device; (2) the semiconductor storage device replying to the first inquiry command from the operation system that the device is an optical disk drive; (3) the operation system of the host computer deeming the semiconductor storage device as an optical disk based on the reply from the semiconductor storage device, and performing an operation accordingly; and (4) the AutoRun mechanism of the operation system searching for an AutoRun configuration file stored in the semiconductor storage device which simulates an optical disk drive so that a specific file directed by the AutoRun configuration file can be executed, the searching step comprising: (4-1) the operation system sending out a second inquiry command to detect whether an optical disk is inserted into the optical disk drive when the semiconductor storage device is deemed to be an optical disk drive; (4-2) **in response to the second inquiry command, the semiconductor storage device, which simulates an optical disk drive, replying to the operation system after a predetermined delay, that an optical disk is already inserted into the optical disk drive so that the operation system can deem the semiconductor storage device as an optical disk with an optical disk;** and (4-3) the AutoRun mechanism of the operation system searching for the AutoRun configuration file stored in the semiconductor storage device which simulates the optical disk drive with an optical disk

so that the operation system can execute the specific file directed by the AutoRun configuration file.

Chang generally describes incorporation of Autorun functionality into an integrated circuit memory device such as any USB peripheral. Chang does not teach or suggest the step of “in response to the second inquiry command, the semiconductor storage device, which simulates an optical disk drive, replying to the operation system after a predetermined delay, that an optical disk is already inserted into the optical disk drive so that the operation system can deem the semiconductor storage device as an optical disk with an optical disk,” as recited in Claims 1 and 11 of the instant application.

The Examiner alleges that this step is inherent in Chang because “in mimicking the operation of CD Rom drive, the USB peripheral would necessarily have to indicate that it was a CD drive with a disk.” Applicants respectfully disagree.

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’ Inherency, however,

may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the instant case, Chang does not mention anything about simulating an optical drive by replying to the operation system after a predetermined delay, nor does this characteristic **necessarily** flow from the teachings of Chang. The Examiner establishes his inherency argument solely on probabilities or possibilities. The mere fact that Chang may use a predetermined delay is not sufficient to establish inherency. Accordingly, Applicants respectfully submit that Claims 1 and 11, as amended, are patentable over Chang. Applicants further submit that Claims 2-7, 13-15 and 18-20 are patentable because they depend from Claim 1 or 11, and recite additional patentable subject matter. Claim 12 has been canceled.

In view of the foregoing, these grounds of rejection have been obviated and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

### **Claim Rejections under 35 U.S.C. §103**

Claims 9, 10, 16 and 17 stand rejected under 35 U.S.C. §103 as being obvious by U.S. Patent Application Publication No. 20050083741 to Chang for the reasons set forth on pages 15-19 of the outstanding Office Action. Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

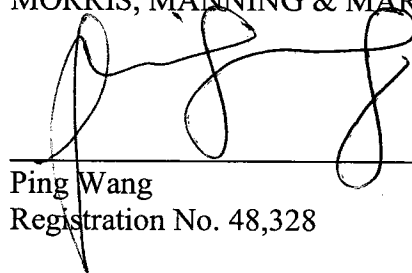
### CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to contact Ping Wang (Reg. No. 48,328) at 202.842.0217.

Respectfully submitted,

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